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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/299,502 · 04/26/99 GAUTHIER

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027805 WM31/0605  
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EXAMINER

GARCIA, G

ART UNIT

PAPER NUMBER

2624

*10*

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/299,502

Applicant(s)  
Gauthler

Examiner  
G. Garcia

Art Unit  
2624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 26, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-10 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-10 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: \_\_\_\_\_

**Part III DETAILED ACTION**

1. This Office action is in response to the amendment filed 3/26/01. Claims 1-10 are pending in this application. After a detailed review of the pending claims, the Examiner concludes that a restriction is required under 35 U.S.C. 121. (explanation follows).

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-4, drawn to a computer implemented method for generating a plurality of bitmaps or reusable template bitmap suitable for high speed printing.

Group II: Claims 5-10, drawn to a computer implemented method of associating a data area defined in a PDL specification with a plurality of variable data items in a merge file.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-II are related as subcombinations disclosed as usable together in a single combination, the combination being the printing system where the two inventions are performed. The

subcombinations are distinct from each other if they are shown to be separately usable.

The inventions are distinct, each from the other because of the following reasons: In the instant case(s), the inventions have separate utility such as to generate a reusable template and store of variable data using character bit maps, and to use a field name and character string matching to generate a merge file, clearly the elements of Group I operates without the claimed elements of Group II. See M.P.E.P. § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Applicant is advised that a response to this requirement must include an identification of the Group that is elected with this requirement, and a listing of all claims readable thereon. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

5. Should applicant traverse on the ground that the inventive groups are not distinct and/or have not acquired a separate status in the art, applicant should submit evidence or identify

such evidence now of record showing the inventive groups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

6. An attempt was made on 6/1/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.

Serial Number: 09/299,502

Art Unit: 2624

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*Gabriel Garcia*

Gabriel I. Garcia

Patent Examiner

May 31, 2001